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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,910	08/02/2001	Takeshi Natsuno	9683/91	9817

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EXAMINER

LABAZE, EDWYN

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,910

Applicant(s)

NATSUNO, TAKESHI

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-10 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8,10 and 13-18 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 4/07/2003.
2. Claims 1, 3-5, 7-10, and 13-18 are presented for examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 14 and 17 are rejected under 35 U.S.C. 102(e) as being unpatented by Schilling (U.S. 6,170,745).

Re claim 14: Schilling discloses wireless debit card system and method, which includes a radio mobile terminal 82 comprising of transmitting means for performing wireless (through transmitter 202) communications with others through a mobile communication network (col.5,

lines 26-67 and col.6, lines 7-67); and a magnetic recording medium or card 30 for storing a plurality of card information items (col.4, lines 15-67).

Re claim 17: Schilling teaches an apparatus/mobile terminal that is served in mobile communication and performs wireless communications, comprising of a memory 206 for storing card information items with regard to one or a plurality of cards (See Figs. # 5 and 6 of Schilling and col.6, line 48); and an output interface or speaker 218 or display 216 for reading out from the memory the card information items so as to be output (col.7, lines 40-67), wherein the output interface comprises a magnetic recording medium 30 (col.6, lines 30+); and a magnetic writer 212 for reading out the card information selected by the selecting means from the memory to be written into the recording medium (col.6, lines 46-67).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling (U.S. 6,170,745) in view of Matsumoto et al. (U.S. 6,425,522).

The teachings of Schilling have been discussed above.

Schilling fails to disclose an infrared interface for emitting infrared rays designating card information read out from the memory.

Matsumoto et al. teaches an IC card information processing system, which includes an infrared ray (col.10, lines 1+).

In view of Matsumoto et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize an infrared interface or transmitters for emitting infrared ray into the teaching of Schilling adapted for information transfer. Furthermore, the advantage of the infrared rays is the ability to read non-carbon inks and enable transmission/reception of data as infrared signal using infrared transmitters. Moreover, such modification would have been an obvious extension as taught by Schilling, therefore an expedient.

8. Claims 1, 3-5, 7, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. in view of Fulton (U.S. 6,259,409).

Re claim 1: Ishii et al. discloses portable electronic device having an external I/O unit and power source integral therewith, which includes a housing 10 having a slot 23 (col.3, lines 5+); a memory (integrated into the microcomputer 24 with Rom and RAM) in the housing configured to store a plurality of data sets, wherein each data set is associated with a card (col.3, lines 1-25); a user interface or smart card 26 coupled to the memory and configured to prompt a user to select a data set from the plurality of data sets (col.3, lines 17+); an output interface 29 coupled and configured to read and output from the memory the selected data (col.4, lines 23+); and wherein the output interface comprises a recording medium or smart/IC card 22 (wherein data could be pre-stored and stored after transactions when coupled onto the terminal) that is readable by an

external device (col.3, lines 7-26); and a writer 16 configured to write the selected data set to recording medium (col.8, lines 1-67).

Ishii et al. fails to suggest that the card is permanently coupled to the slot and movable between retracted and protruding positions.

Fulton discloses retractable sliding antenna assembly for wireless communication, which includes a sliding assembly housed within a pc card 311 and permanently coupled into a retracted and protruded positions (See Fig. # 10 of Fulton and col.7, lines 40-67 and col.8, lines 1-67), and further teaches that the device is selectetable from a group consisting of pc cards, mobile phones and the like (col.14, lines 16+).

In view of Fulton's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teaching of Ishii et al. a sliding assembly wherein the recording medium or card is permanently coupled to the slot and movable between retracted and protruding positions in order terms half-way inserted into the slot of the housing. Furthermore, such modification would be beneficial to the user and permit easy access to printed or encoded information onto the card while using the card, which would have not been possible if the card were concealed within the housing or in a retracted position. Moreover, such modification would have been an obvious extension as taught by Ishii et al.

Re claim 3: Ishii et al. as modified by Fulton teaches an apparatus, wherein each of the data sets includes information required for electronic-commerce (through a modem) transactions (col.3, lines 37-62 and col.4, lines 15-46).

Re claim 4: Ishii et al. as modified by Fulton discloses an apparatus, wherein the information required for electronic commerce transactions includes credit card information (col.6, lines 3+).

Re claim 5: Ishii et al. as modified by Fulton teaches an apparatus, wherein the each of the data sets includes information for identifying the user or personal authorization number (col.6, lines 10+).

Re claim 7: Ishii et al. as modified by Fulton discloses an apparatus, wherein the recording medium 22 is a card-shaped recording medium that can be read by a card reading device 17 (See Fig. # 3 of Ishii et al. and col.3, lines 1+).

Re claim 10: Ishii et al. as modified by Fulton teaches an apparatus, wherein the output interface comprises a code displaying device 13 for displaying code that corresponds to the selected data set, the code being optically readable (col.).

Re claim 13: Ishii et al. as modified by Fulton teaches an apparatus, wherein the mobile communication terminal 10 is a mobile telephone for performing wireless telephone communications (col.6, lines 10-40).

9. Re claims 8, 15-16: Ishii et al. fails to suggest that writing information on the recording medium is operable in both the retracted and protruded positions.

Fulton teaches an apparatus, wherein the sliding device has two operable of retracted and protruded positions (col.8, lines 20+).

In view of Fulton's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Ishii et al. a sliding assembly operable in both the retracted and protruded positions. Furthermore, such modification

would provide to the user a choice of operable position (retracted or protruded) when writing and saving information on the recording medium or card and prevent data lost when switching from one position to the other. Moreover, such modification would have been an obvious extension of the teaching of Ishii et al., therefore an expedient.

Allowable Subject Matter

10. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: The best prior of record, taken alone or in combination with ant other reference, fails to teach a mobile terminal, which includes a recording medium permanently coupled to the insertion slot of the mobile/portable terminal and movable between retracted and protruding positions, and when the recording medium protrudes out of the mobile terminal is retracted inside the mobile terminal deletes the selected data written in the recording medium. These limitations in conjunction with other limitations in the claims were not shown by the prior art of record.

Response to Arguments

Applicant's arguments filed on 4/07/2003 have been fully considered but they are moot in light of the new ground of rejection.

The applicant recites the new limitations a housing having a slot, a user interface coupled to the memory to prompt a user to select a data from the plurality of data sets. These limitations

were not disclosed in the original claims and are rejected by the new prior art, Ishii et al., cited by the examiner (see discussions above).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Glad et al. (U.S. 6,164,989) discloses adaptable communication connectors.

Hannon et al. (U.S. 5,850,440) teaches telephone handset mounting receptacle with card reader and method of positioning thereof.

Jonstromer (U.S. 6,142,369) discloses electronic transaction terminal for conducting electronic financial transactions using a smart card.

Cheng et al. (U.S. 6,035,216) teaches device for receiving a SIM card for portable telephone set.

Wakabayashi et al. (U.S. 6,454,164) discloses pocketsize information transfer apparatus having dual IC card insertion slots and IC card using the same.

Yamashita (U.S. 5,809,432) teaches portable radio terminal having a removable radio system unit.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
June 30, 2003


MICHAEL G. LEE
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